



Patent
Attorney's Docket No. 050001

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)
Franz-Georg HANISCH, et al.)
Application No. 09/940,253)
09/931,638)
Filed: August 17, 2001)
August 16, 2001)
For: Peptide Variants of the)
Tumour Marker MUC-1 and)
the Use Thereof)

Group Art Unit:

Examiner: Unassigned

Confirmation No.: 2700

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JAN 11 2007

OFFICE OF PETITIONS

Petition Under 37 C.F.R. §§ 1.181(a) and 1.183 To Rescind Notice of Abandonment

Mail Stop Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is a Petition to withdraw the holding of abandonment and resume prosecution in the United States Patent Application No. 09/931,638, which is apparently also styled Application No. 09/940,253. The Notice of Abandonment under 37 C.F.R. §§ 1.53 (f) or (g) indicates that Application No. 09/931,638 was abandoned for failure to timely or properly reply to a Notice to File Missing Parts mailed on October 18, 2001. The Notice of Abandonment in the '638 application is dated November 24, 2003. The undersigned is not aware of a Notice of Abandonment in the '253 application.

Applicants submit that the abandonment of the '638 application was improper because a reply to the outstanding action was submitted by then Attorney of Record Mr. Gabriel P. Katona, of the law firm Goodwin Procter LLP. Mr. Katona is now deceased. As discussed more fully below, the undersigned did not obtain responsibility for the application(s) until February 2005.

Applicants submit that the purported abandonment of the application likely resulted from confusion regarding the file number of the '638 application and the '253 application. These applications appear to have been kept in the same file by the United States Patent and Trademark Office. It is demonstrated by the copy of the file history in the '638 application that we obtained on October 25, 2006. That file history contains documents for both files.

To facilitate allowance of this Petition, Applicants wish to provide some background information. The '638 application was filed on August 16, 2001 and the '253 application was filed on August 17, 2001. A Notice of Missing Parts was mailed out in each case on October 18, 2001. On November 9, 2001 a partial response to that Notice of Missing Parts was sent, and on November 27, 2001 a further Response was sent. Copies of those responses are included with the petition included herewith, accompanied by their stamped return postcards. Those documents also appear to have been entered on the file jacket of the '638 application, but they are no longer in that file.

Although no copy of the originally filed disk was present in the file received by the undersigned, a new disk has been created bearing the sequence identification listing produced with the original response, and the listing on the disk is the same as that on paper. Applicant notes that the original transmittal of the sequence listing and diskette states "Enclosed herewith is a printout of a sequence listing for the above-identified application, together with a floppy disk *containing the same*." (Emphasis added.) It is believed that this statement was sufficient to satisfy the requirement that a statement be made regarding the identity of the paper and disk copies of the sequence listing.

No further substantive communication from the Patent Office appears in the Applicant's file for this case, and a telephone call with Goodwin Procter indicated that their docketing entries also do not indicate receipt of any further documents.

The file history of the '638 patent contains a Notice of Abandonment of that case dated November 24, 2003. No copy of that Notice is in applicants' file. This date is over two years later than the initial mailing date of the Notice of Missing Parts and almost two years after Applicants made their bona fide attempt to respond to the Notice. The undersigned is not aware of any further action in the case until the responsibility for the application was transferred to Buchanan Ingersoll PC (now Buchanan Ingersoll & Rooney PC) by Power of Attorney

documents dated February 5, 2005 and submitted to the Office on February 25, 2005. Those documents were sent with a duly signed Request for Status Report on the application.

No response to the Status Request having been received, and with information on the application unavailable by either public or private Pair, another Status Request was made in August 2006 by calling representatives of the PTO for assistance. This work was performed by my assistant Angelina Beyerl. It was during this status request that we discovered that the application was purportedly abandoned. This was also when we discovered that the '638 and '253 applications had apparently been treated as the same application by the Office.

We immediately proceeded to order the file history which we obtained on October 25, 2006. After reviewing the file history to determine the status of the '638 and '253 applications to the best of our ability, we drafted a letter advising our contact with the assignee of the current status of the application and requesting instructions. On November 28, 2006, we were given instructions to file a Petition to revive the application and we immediately proceeded to prepare one. A signed petition was received on January 5, 2007, and is being filed on that same day. Applicants regret the relatively poor quality of the facsimile reproduction, but note that this was filed in lieu of the original document in the interest of time.

Applicants sincerely request withdrawal of the Notice of Abandonment as well as any other relief that the Commissioner deems available and appropriate. The undersigned suggests that all earnest efforts have been made to prosecute this application since it entered his custody and that further, based on the file that was received from Goodwin Proctor LLP, diligent efforts were made during the time preceding my receipt of the file. The undersigned stresses that there is no copy of any Notice of Abandonment in the applicants' file for the '638 application and no record of any Notice in Goodwin Procter's docketing system. The undersigned has also not been able to obtain any Notice of Abandonment (if indeed one exists) for the '253 application.

As an additional matter, the undersigned brings to the attention of the Commissioner the Petition for Revival of an Application for Patents Abandoned Unintentionally under 37 C.F.R. §1.137(b), which is filed concurrently with this Petition. It is signed by Dr. Bernd Fronhoff, Managing Director of the Cell Center Cologne GmbH. The Cell Center is the current assignee of this application, as reflected by the assignment at Reel and Frame No. 013875/4083. Due to the death of Mr. Katona and subsequent transfer of the application, it is submitted that the representative of the assignee is the proper person to attest that the "entire delay" for providing

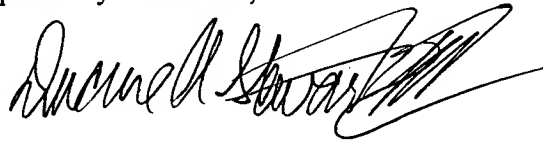
an additional copy of the Reply (which was previously submitted) and for requesting revival of the case was unintentional.

The undersigned would further like to stress that due to the purportedly abandoned status of the '638 and '253 applications, their absence in PAIR, and their apparently having been kept in a common file, great and diligent effort was necessary to obtain the file history and determine the status of the application(s) at all. The undersigned believes that during the time period from the November 2001 responses to the Notice of Missing Parts to the telephonic indication by representatives of the Office that the Application was abandoned, the Applicant was merely awaiting further action on the case and believed the case to be pending.

In light of the confusing circumstances surrounding these cases, the original submission of a bona fide reply to the Notice of Missing Parts, and the apparent nonreceipt of a Notice of Abandonment in either 09/931,638 and 09/940,253 applications, the Applicant requests reinstatement of the 09/940,253 application. As a final matter, Applicant notes that no file jacket for the 09/940,253 application was able to be obtained, and therefore Applicants still have not seen any Notice of Abandonment for this case. It is assumed only for the purposes of this Petition and without any admission that the '253 application has been abandoned. If it has not been abandoned, then a status report is requested.

The undersigned earnestly requests suitable action on this Petition and reinstatement of one or both of these application. Given the nature of these cases, the undersigned would also appreciate a telephone call in advance of any decision in the event that the Commissioner or his designee have any questions about the status of the case or require more information.

Respectfully submitted,



January 5, 2007

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